

REMARKS

1. Summary of the Office Action

Claims 34-41, 45-50, 52, 54-59, 61-63, 65, 66, 69-75, 77-84 88-93, 95, 97-102, 104-106, 108, 109, 112-118 and 120 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Serial No. 4,803,625, hereinafter (Fu) in view of U.S. Patent No. 4,838,275 (Lee) and U.S. Patent No. 5,390,238 (Kirk).

2. Response to § 103 Rejections

Applicant respectfully traverses this rejection for the reasons set out below, and asks the Examiner for reconsideration.

It is well established that “to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) must **teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” See MPEP §706.02(j) (*emphasis added*)

It is respectfully submitted that, for the reasons below, the Examiner has not met this burden as there is no suggestion in the references to combine them and there is no reasonable expectation of success, specifically because the references teach away from such combination.

**THE PRIOR ART REFERENCES TEACH AWAY FROM THE PRESENT
INVENTION.**

The Examiner has acknowledged that Fu does not teach “at least one health care professional computer remotely located from...the central server to receive at least one report...” Instead the Examiner relies on Lee to provide this limitation.

But, because the Lee reference has a human operator at the central office, the Examiner acknowledges that the Fu and Lee combination does not, and indeed cannot, teach the claimed limitation where the “server automatically communicates with the data management units and at least one health care professional computer.”

Thus, the Examiner is forced to go to yet another reference – Kirk – to provide this limitation, asserting that “it would have been obvious to one of ordinary skill in the art ... to include the aforementioned limitation....” The Examiner is, however, incorrect in this assertion.

As pointed out, the claim requires automatic communication between the server and the data management units and health care provider. **By “automatic” is meant without a human intermediary.**

In stark contrast, Lee provides “a highly trained observer at the central office [that] supplements the electronic measurements” (see abstract). Col 22, lns. 17-24 states that this is the “person who ... refers problems to the appropriate physician, and initiates system responses.”

Lee is, therefore, an essentially human based system where a skilled human being makes decisions about where to direct information. It is totally contrary to such systems to replace the highly trained human with a computer. Also, those skilled in the art of computer networked systems such as Fu and Kirk would never consider replacing servers or central computers with humans. Thus combining Lee with either Fu or Kirk

would be contrary to the philosophical underpinnings and, therefore, not at all obvious to one skilled in the art.

In addition, the Fu, Lee and Kirk systems are technically very different solutions. Fu is a mainframe-based system, Lee (as indicated) requires a human operator as an intermediary, and Kirk is fragmented architecture. It is not correct to argue that, merely because these systems all relate to health care, is obvious to combine them.

Moreover, the technical challenges of combining Lee with either Fu or Kirk would be enormous. It would require swapping out the sophisticated human operator in Lee and replacing the human with the computers of either Fu or Kirk. It is submitted that it is technically very difficult, if not impossible, to do and there is no suggestion at all that this can be done and, accordingly, no possible expectation for success. Such technical difficulties therefore teach away from, and render non-obvious, the proposed combination.

Accordingly, it appears that the Examiner has selectively chosen features from each of the references and, using impermissible hindsight, mosaiced these features together to make an allegedly obvious system.

In light of the above, Applicant respectfully submits that the rejection under 35 U.S.C. § 103 has been overcome, and withdrawal of this rejection is therefore respectfully requested. This would make the independent claims patentable, thus rendering patentable all dependent claims.

In addition, attached is an affidavit under 37 CFR § 1.131 showing conception and reduction to practice of the invention claimed in this patent application prior to the effective date of the Kirk reference cited by the Examiner.

3. Conclusion

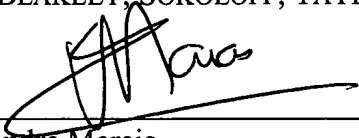
Having tendered the above remarks, Applicant respectfully submits that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Garth Vivier at (408) 947-8200 ext. 245.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 07/01/2004



Andre Marais
Reg. No. 48,095

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026
(408) 947-8200